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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,529	01/20/2004	Masayuki Matsui	Q79426	7099
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EXAMINER				
PADEN, CAROLYN A				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
02/13/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/759,529

**Applicant(s)**

MATSUI ET AL.

**Examiner**

Carolyn A. Paden

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-8, 10 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knowlton (5,985,781) for reasons of record used in rejecting claims 1-3, 10 and 21.

Knowlton discloses soybean oil having high oxidative stability. At column 5, lines 17-30, utility of the oil in confectionery foods is disclosed. At column 11, lines 48-52, the addition of 30 ppm citric acid is shown and at column 12, lines 18-24, the addition of 50 ppm citric acid is shown. Further at column 11, lines 44-51, deodorization of the oil is stated to occur after the addition of organic acid and at 100 C, with vacuum. Although drying is not specifically mentioned, one of ordinary skill in the art would expect the treatment of the oil would dry it. It is appreciated that the vacuum conditions are not the same but one of ordinary skill in the art would expect the speed of drying to vary with the extent of vacuum applied to the oil.

Applicant argues that the Declaration is sufficient to overcome the rejection over Knowlton. This is disagreed with. The Declaration does not

address Knowlton at all. Further the Declaration points to the importance of the extent of ascorbic acid in the oil but the claims distinguish between 60 ppm and 1 ppm. The aspect of the process limitation in claim 1 is not seen to carry any weight because the claims are directed to a product.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5-7, 10 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Knowlton (5,985,781).

Knowlton discloses soybean oil having high oxidative stability. At column 5, lines 17-30, utility of the oil in confectionery foods is disclosed. At column 11, lines 48-52, the addition of 30 ppm citric acid is shown and at column 12, lines 18-24, the addition of 50 ppm citric acid is shown. Further at column 11, lines 44-51, deodorization of the oil is stated to occur after the addition of organic acid and at 100 C, with vacuum. Although drying is not specifically mentioned, one of ordinary skill in the art would expect the treatment of the oil would dry it. It is appreciated that the vacuum

conditions are not the same but one of ordinary skill in the art would expect the speed of drying to vary with the extent of vacuum applied to the oil.

Further claim 1 is directed to a product and not a process. Process limitations do not carry any weight in product claims.

Applicant argues that the Declaration is sufficient to overcome the rejection over Knowlton. This is disagreed with. The Declaration does not address Knowlton at all. Further the Declaration points to the importance of the extent of ascorbic acid in the oil but the claims distinguish between 60 ppm and 1 ppm. The aspect of the process limitation in claim 1 is not seen to carry any weight because the claims are directed to a product.

Claims 4-16, 18-21 and 25 rejected under 35 U.S.C. 103(a) as being unpatentable over Knowlton as applied to claims 1-3, 5-8, 10 and 21 above, and further in view of Takeda.

The claims appear to differ from Knowlton in the recitation that the fat is hard butter. Takeda discloses shortening for chocolate. At column 4, lines 17-26, anti-oxidants, such as citric acid and ascorbic acid are described as known additives for shortening. The chocolate would be expected to be an emulsified food because it contains both oil and water-based ingredients. It would have been obvious to one of ordinary skill in

the art to use the organic acids of Knowlton to treat the shortening of Takeda in order to stabilize the fats.

Applicants' declaration has been considered but is not sufficient to overcome the rejection of the claims over Knowlton in view of Takeda. The rejection of the claims over Takeda in view of Loliger has been withdrawn.

The rejection of the claims over Loliger in view of Takeda has been withdrawn.

Claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pires (2002/0119238) for reasons of record.

Applicant argues that Pires does not disclose the method of adding the organic acid but the claims merely call for using a fat with an organic acid. So no weight is attached to these arguments. The Declaration does not compare Pires with his claimed invention to the Declaration is not sufficient to overcome the rejection.

Claims 16-19 and 21-24 rejected under 35 U.S.C. 103(a) as being unpatentable over Durmoulin (5,958,503) as further evidenced by Lowe and in view of Takeda ((5,928,704) for reasons of record.

Applicant argues features of the process that are not a part of the claims. The recitation "using a fat" is not seen to impart all of the process

features that applicant urges in his arguments. The declaration filed has been considered but is not persuasive because it does not compare Durmoulin with the claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn A Paden whose telephone number is (571) 272-1403. The examiner can normally be reached on Monday to Friday from 7 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano, can be reached by dialing 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Carolyn Paden/

Primary Examiner 1794